

REMARKS

Claims 1 through 23 are currently pending in the application.

This amendment is in response to the final rejection of the pending claims in the Office Action of March 15, 2006.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on Docter *et al.* (U.S. Patent 6,330,610)

Claims 1 through 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Docter *et al.* (U.S. Patent 6,330,610) (hereinafter “Dokter”). Applicant respectfully traverses these rejections.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to inherency, M.P.E.P. § 2112 provides:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) . . . ‘To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill . . .’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1991).

With respect to enabling disclosures, M.P.E.P. § 2121.01 provides that “[t]he disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.”

Independent claim 1 recites a printing system, comprising . . . a printer including . . . a processor, and a printing component in communication with the processor, and a filtering program associated with the processor so as to control printing of a file by the printing

component based on at least one of a presence or absence of at least one prespecified characteristic from a packet including said file.

Applicant asserts that Docter does not identically describe, either expressly or inherently, each and every element of independent claim 1 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Regarding independent claim 1, the Office suggested that the invention of Docter may be applied to “any device containing a processor or controller capable of executing instructions.” *Final Office Action mailed March 15, 2006, p. 2*. Applicant asserts that Docter does not provide an enabling disclosure for “a filtering program associated with said [printer] processor so as to control printing of a file.” Applicant asserts that throughout Docter “various embodiments are discussed that include a client coupled to one or more servers.” *Col. 3, lines 19-21*. Applicant asserts that Docter addresses the problem that “[s]ince the server is unable to filter data based on private criteria not provided to the server by the user, the user may receive a significant amount of irrelevant data. This irrelevant data is time consuming to review and creates a distraction from the user’s normal work or activities.” *Col. 1, lines 42-46*. Applicant asserts that Docter is related to “a system for filtering data in multiple stages without exposing private information to untrusted servers.” *Col. 1, line 66 to Col. 2, line 1*. Applicant asserts that the lone sentence in Docter attempting to apply the invention of Docter to “any type of device containing a processor or controller” does not provide an enabling disclosure for a printer. *Col. 3, lines 21-23*. Additionally, Applicant asserts that it is not necessarily present in Docter that a client is a printer. Therefore, Applicant asserts that Docter does not expressly or inherently describe filtering data sent to a printer as required by claim 1.

Applicant asserts that Docter does not describe “printing of a file . . . based on at least one of a presence or absence of at least one prespecified characteristic from a packet including said file.” Applicant asserts that the data of Docter “may be in the form of advertisements” and “news articles” or “related to a subject that is of no interest to the recipient or related to a type of product that the recipient does not use and does not intend to purchase.” *Col. 1, lines 15-23*. As noted by the Office, “[t]he data of Docter is actually profile data.” *Final Office Action mailed March 15, 2006, p. 2*. Additionally, it is not

necessarily present that the data of Docter is a packet including a file to be printed.

Therefore, Docter does not describe expressly or inherently the type of data recited in claim 1.

Applicant additionally asserts that Docter does not describe a filtering program able “to control printing of a file by the printing component.” As noted by the Office, the data of Docter is actually profile data, which is subject to the filtering criteria. *Final Office Action mailed March 15, 2006, p. 2-3*. Applicant asserts that it is not necessarily present in Docter that the filtering program of Docter is operable to control the printing by a printing component. Therefore, Docter does not expressly or inherently describe a filtering program able “to control printing of a file by the printing component.”

Therefore, for at least the above reasons, Docter does not anticipate independent claim 1 under 35 U.S.C. § 102. Accordingly, independent claim 1 is allowable.

Claims 2 through 10 are allowable for at least the reason of depending either directly or indirectly from allowable independent claim 1.

Claim 2 is additionally allowable since Docter does not describe expressly or inherently a filtering program stored by at least one of a memory device and firmware of a printer associated with a processor.

Claim 6 is further allowable since Docter does not describe expressly or inherently a filtering program that causes a processor to prevent a printing component from printing a file of a packet having at least one undesirable characteristic.

Claim 7 is further allowable since Docter does not describe expressly or inherently a filtering program that instructs a processor to cause a printing component to print a file of a packet having a desirable characteristic.

Claim 8 is further allowable since Docter does not describe expressly or inherently a filtering program that instructs a processor to cause a printing component to print a file only if a packet lacks an undesirable characteristic and has a desirable characteristic.

Claim 9 is further allowable since Docter does not describe expressly or inherently an undesirable characteristic comprising one of a file type, a file string, a source computer identifier, a user identifier, a file size, and at least one prespecified command. It was suggested that it is inherent that criteria can be designated within specified criteria. *Final Office Action mailed March 15, 2006, p. 8*. Docter describes data profile elements related to user-specific information (e.g., age, occupation, or marital status), user roles (e.g., professor

or V.P. of Engineering), and user class (*e.g.*, marketing or engineers). *Col. 6, lines 5-27*. Applicant asserts that it is not necessarily present in Docter that the data profile elements include at least one of a file type, a file string, a source computer identifier, a user identifier, a file size, and at least one prespecified command. Therefore, for at least this reason, Docter does not anticipate dependent claim 9 under 35 U.S.C. § 102. Accordingly, dependent claim 9 is allowable.

Claim 10 is further allowable since Docter does not describe expressly or inherently a desirable characteristic comprising one of a source computer identifier, a user identifier, a file type, and a password. Docter describes data profile elements related to user-specific information (*e.g.*, age, occupation, or marital status), user roles (*e.g.*, professor or V.P. of Engineering), and user class (*e.g.*, marketing or engineers). *Col. 6, lines 5-27*. Applicant asserts that it is not necessarily present in Docter that the data profile elements include one of a source computer identifier, a user identifier, a file type, and a password. Therefore, for at least this reason, Docter does not anticipate dependent claim 10 under 35 U.S.C. § 102. Accordingly, dependent claim 10 is allowable.

Presently amended independent claim 11 recites a device-specific filtering method, comprising . . . transmitting a printing packet comprising at least one file from a source computer, across a network, to a device of the network, evaluating at least one prespecified characteristic of the printing packet following passage of the printing packet through a server of the network, and controlling at least one of further transmission of the printing packet to the device and processing of the at least one file of the printing packet by the device based on the evaluating.

Applicant asserts that Docter does not identically describe, either expressly or inherently, each and every element of independent claim 11 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Regarding independent claim 11, the Office suggested that the invention of Docter may be applied to “any device containing a processor or controller capable of executing instructions.” *Final Office Action mailed March 15, 2006, p. 4*. Applicant asserts that Docter does not provide an enabling disclosure for “transmitting a printing packet.” Applicant asserts that the lone sentence in Docter attempting to apply the invention of Docter to “any type of device containing a processor or controller” does not provide an enabling disclosure. *Col. 3, lines*

21-23. Applicant asserts that throughout Docter “various embodiments are discussed that include a client coupled to one or more servers.” *Col. 3, lines 19-21*. Applicant asserts that Docter addresses the problem that “[s]ince the server is unable to filter data based on private criteria not provided to the server by the user, the user may receive a significant amount of irrelevant data. This irrelevant data is time consuming to review and creates a distraction from the user’s normal work or activities.” *Col. 1, lines 42-46*. Applicant asserts that Docter is related to “a system for filtering data in multiple stages without exposing private information to untrusted servers.” *Col. 1, line 66 to Col. 2, line 1*. Applicant asserts that Docter does not describe filtering data sent to a printer. Applicant asserts that neither is it necessarily present in Docter that the client is a printer. Therefore, Applicant asserts that Docter does not expressly or inherently describe evaluating data sent to a printer as required by claim 11.

Applicant further asserts that the data of Docter “may be in the form of advertisements” and “news articles” or “related to a subject that is of no interest to the recipient or related to a type of product that the recipient does not use and does not intend to purchase.” *Col. 1, lines 15-23*. Docter does not describe evaluating a printing packet. Applicant asserts that it is not necessarily present in Docter that the advertisements filtered by Docter are printing packets. Therefore, Docter does not describe expressly or inherently the type of data recited in claim 11.

The Office suggested it was inherent that a printer will receive/process instructions that are printer-type as substantiated by the device specific firewalls of Kenworthy (U.S. Patent 6,317,837). *Final Office Action mailed March 15, 2006, p. 4*. Applicant asserts that it is not necessarily present in Docter that if the client of Docter is modified to be a printer that the data presented to the client-now-printer will change.

Applicant additionally asserts that the filtering system of Docter does not describe “controlling at least one of further transmission of said printing packet to said device and processing of said at least one file of said printing packet by said device based on said evaluating.” As noted by the Office, “[t]he data of Docter is actually profile data . . . which is subject to the filtering criteria.” *Final Office Action mailed March 15, 2006, p. 4*. Additionally, it is not necessarily present in Docter that the filtering system exercises control over the printing or further processing of a file. Therefore, Docter does not expressly or

inherently describe “controlling at least one of further transmission of said printing packet to said device and processing of said at least one file of said printing packet by said device based on said evaluating.”

Therefore, for at least the above reasons, Docter does not anticipate independent claim 11 under 35 U.S.C. § 102. Accordingly, independent claim 11 is allowable.

Claims 12 through 19 are allowable for at least the reason of depending either directly or indirectly from allowable independent claim 11.

Claim 13 is further allowable since Docter does not describe expressly or inherently preventing an at least one of further transmission of a printing packet to a device and processing of an at least one file of the printing packet by the device if the printing packet has an undesirable characteristic.

Claim 14 is further allowable since Docter does not describe expressly or inherently permitting an at least one of further transmission of a printing packet to a device and processing of an at least one file of the printing packet by the device if the printing packet has a desirable characteristic.

Claim 15 is further allowable since Docter does not describe expressly or inherently permitting an at least one of further transmission of a printing packet to a device and processing of an at least one file of the printing packet by the device if the printing packet lacks at least one undesirable characteristic and has at least one desirable characteristic.

Claim 16 is further allowable since Docter does not describe expressly or inherently an undesirable characteristic comprising one of a file type, a file string, a source computer identifier, a user identifier, a file size, and at least one prespecified command. Docter describes data profile elements related to user-specific information (*e.g.*, age, occupation, or marital status), user roles (*e.g.*, professor or V.P. of Engineering), and user class (*e.g.*, marketing or engineers). *Col. 6, lines 5-27*. Applicant asserts that it is not necessarily present in Docter that the data profile elements include one of a file type, a file string, a source computer identifier, a user identifier, a file size, and at least one prespecified command. Therefore, for at least this reason, Docter does not expressly or inherently anticipate dependent claim 16 under 35 U.S.C. § 102. Accordingly, dependent claim 16 is allowable.

Claim 17 is further allowable since Docter does not describe expressly or inherently a desirable characteristic comprising one of a source computer identifier, a user identifier, a file

type, and a password. Docter describes data profile elements related to user-specific information (*e.g.*, age, occupation, or marital status), user roles (*e.g.*, professor or V.P. of Engineering), and user class (*e.g.*, marketing or engineers). *Col. 6, lines 5-27*. Applicant asserts that it is not necessarily present in Docter that the data profile elements include one of a source computer identifier, a user identifier, a file type, and a password. Therefore, for at least this reason, Docter does not anticipate dependent claim 17 under 35 U.S.C. § 102. Accordingly, dependent claim 17 is allowable.

Independent claim 20 recites a system for filtering a file transmitted to a destination device, comprising . . . a processor in communication with a network across which the file has been transmitted, and a filtering program associated with the processor so as to control at least one of transmission of a packet including at least one file to be printed to the destination device and processing of the at least one file to be printed by the destination device based on at least one of a presence or absence of at least one prespecified characteristic from the packet including the at least one file to be printed.

Applicant asserts that Docter does not identically describe, either expressly or inherently, each and every element of independent claim 20 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Regarding independent claim 20, the Office suggested that the invention of Docter may be applied to “any device containing a processor or controller capable of executing instructions.” *Final Office Action mailed March 15, 2006, p. 4*. Applicant asserts that Docter does not provide an enabling disclosure for a destination device capable of printing. Applicant asserts that the lone sentence in Docter attempting to apply the invention of Docter to “any type of device containing a processor or controller” does not provide an enabling disclosure. *Col. 3, lines 21-23*. Applicant asserts that throughout Docter “various embodiments are discussed that include a client coupled to one or more servers.” *Col. 3, lines 19-21*. Applicant asserts that Docter addresses the problem that “[s]ince the server is unable to filter data based on private criteria not provided to the server by the user, the user may receive a significant amount of irrelevant data. This irrelevant data is time consuming to review and creates a distraction from the user’s normal work or activities.” *Col. 1, lines 42-46*. Applicant asserts that Docter is related to “a system for filtering data in multiple stages without exposing private information to untrusted servers.” *Col. 1, line 66 to Col. 2, line 1*. That does not enable

filtering data sent a destination device capable of printing. Additionally, Applicant asserts that it is not necessarily present in Docter that a client is a destination device capable of printing. Therefore, Applicant asserts that Docter does not expressly or inherently describe filtering data sent to a destination device capable of printing as required by claim 1.

Applicant further asserts that the data of Docter “may be in the form of advertisements” and “news articles” or “related to a subject that is of no interest to the recipient or related to a type of product that the recipient does not use and does not intend to purchase.” *Col. 1, lines 15-23*. Applicant asserts that it is not necessarily present in Docter that the advertisements filtered by Docter include files to be printed. Therefore, Applicant asserts that Docter does not expressly or inherently describe filtering files to be printed as required by claim 20.

The Office suggested it was inherent that a printer will receive/process instructions that are printer-type as substantiated by the device specific firewalls of Kenworthy (U.S. Patent 6,317,837). *Final Office Action mailed March 15, 2006, p. 4*. Applicant asserts that it is not necessarily present in Docter that if the client of Docter is modified to be a printer that the data presented to the client-now-printer will change.

Applicant additionally asserts that the filtering system of Docter does not describe “to control at least one of transmission of a packet including at least one file to be printed to the destination device and processing of said at least one file to be printed by the destination device based on at least one of a presence or absence of at least one prespecified characteristic from said packet including said at least one file to be printed.” As noted by the Office, “[t]he data of Docter is actually profile data . . . which is subject to the filtering criteria.” *Final Office Action mailed March 15, 2006, p. 4*. Additionally, it is not necessarily present in Docter that the filtering system exercises control over the printing or further processing of a file. Therefore, Docter does not expressly or inherently describe “to control at least one of transmission of a packet including at least one file to be printed to the destination device and processing of said at least one file to be printed by the destination device based on at least one of a presence or absence of at least one prespecified characteristic from said packet including said at least one file to be printed.”

Therefore, for at least the above reasons, Docter does not anticipate independent claim 20 under 35 U.S.C. § 102. Accordingly, independent claim 20 is allowable.

Claims 21 through 23 are allowable for at least the reason of depending either directly or indirectly from allowable independent claim 20.

Applicant asserts that claims 1 through 23 are clearly allowable over the cited art.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment does not require any further search or consideration.

The amendment places the application in condition for allowance.

Respectfully submitted,



James R. Duzan
Registration No. 28,393
Attorney for Applicant
TRASKBRITT, P.C.
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: May 8, 2006
JRD/ps:dlm:lmh

Document in ProLaw